

Docket No. 87305.0025
Customer No. 30734

Patent

REMARKS

Claims 1-14 are pending in the application. Claims 1-14 have been amended to claim a grinding belt and claims 1, 4, 6-8 and 10-14 have been further amended to obviate rejections made under 35 U.S.C. §112.

Claims 1-14 were rejected under 35 U.S.C. §112, second paragraph as being indefinite. Reconsideration and withdrawal of the rejection are respectfully requested. It is respectfully submitted that the amendments to the claims submitted herewith obviate the rejection. Therefore, withdrawal of the rejection is respectfully requested.

Claims 1, 2 and 9 were rejected under 35 U.S.C. §103(a) as being obvious over Muller (DE 89 04 270) in view of Angell (U.S. Patent No. 149,424). Reconsideration and withdrawal of the rejection are respectfully requested.

The present invention as recited in claim 1 includes the feature of a “[g]rinding belt” having “an elongated hole whose length corresponds roughly to a width of the material machining belt” wherein the expansion in “the first region is greater than the expansion in the second region.” One advantage of the invention is that when the elongated hole corresponds roughly to the width of the grinding belt a counterpiece can be simply pushed into the hole on the first end (see page 3, 8th complete paragraph of the specification of the present application).

Muller discloses a shape mated connection device to form an endless belt. One end of the belt has a recess with a closed edge. The recess is rectangular in shape and has a length that is smaller than the width of belt.

Angell discloses a band iron cotton bale tie. This tie is used to form a simple and handy tie which provides a strong tie for bales of all kinds.

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Muller fails to disclose a “[g]rinding belt” having “an elongated hole whose length corresponds roughly to a width of the material machining belt” as recited in claim 1, which allows a counterpiece to be simply pushed into the hole on the first end (see page 3, 8th complete paragraph of the specification of the present application). Muller at best discloses an elongated rectangular hole 18 that has a length that is **smaller** than the width of the belt 19. Muller fails to disclose a “grinding belt” having “an elongated hole whose length **corresponds roughly to a width of the material machining belt**” as recited in claim 1.

Muller also fails to disclose a “[g]rinding belt” having a recess wherein the expansion in “the first region is greater than the expansion in the second region” as recited in claim 1. Muller discloses a rectangular hole having the **same** width along the longitudinal axis. Muller fails to disclose two expansions having **differing** widths as recited in claim 1.

It is argued in the outstanding Office Action that Angell discloses the features of
1) a “[g]rinding belt” having “an elongated hole whose length corresponds roughly to a width of the material machining belt”
2) a “[g]rinding belt” having a recess wherein the expansion in “the first region is greater than the expansion in the second region”

as recited in claim 1 of the present application. Angell fails to disclose the above features of the invention as recited in claim 1.

The invention as recited in claim 1 of the invention claims “[g]rinding belt” having “an elongated hole whose length corresponds roughly to a width of the material machining belt” and a “[g]rinding belt” having a recess wherein the expansion in “the first region is greater than the expansion in the second region”. Angell is directed to cotton bale ties, a nonanalogous art.

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No motivation has been provided to show why someone in the grinding belt industry would look into the cotton bale tie art to solve problems associated with grinding belts as required (see MPEP 2141.01(a) "Analogy in Mechanical Arts").

It is further submitted that hindsight reasoning has been used in rejecting the claims of the present application. The advantages specified in the present applications are used in the outstanding Office Action as the reasoning for combining the references which is improper. MPEP 2143 states that "[t]he teachings or suggestion to make the claimed combination and the reasonable expectation for success must both be found in the prior art, not the applicants disclosure. The fact that the references can be combined or modified is not sufficient to establish *prima facie* obviousness. "Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." (see MPEP 2142.01 page 2100-124, August 2001 under the heading "FACT THAT THE REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA FACIE OBVIOUSNESS"). Thus, the motivation provided in the Office Action is improper.

In view of the foregoing, withdrawal of the rejection is respectfully requested.

Claims 1 and 2 were rejected under 35 U.S.C. §103(a) as being unpatentable over Takagi et al. (JP 408 126 962) in view of Ashworth (U.S. Patent No. 86,123) or Voltz (U.S. Patent No. 2,646,940). Reconsideration and withdrawal of the rejection is respectfully requested.

The present invention as recited in claim 1 includes the feature of a "[g]rinding belt" having "an elongated hole whose length corresponds roughly to a width of the material machining belt" wherein the expansion in "the first region is greater than the expansion in the second region." One advantage of the invention is that when the elongated hole corresponds

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roughly to the width of the grinding belt a counterpiece can be simply pushed into the hole on the first end (see page 3, 8th complete paragraph of the specification of the present application).

Takagi et al. is directed to a lapping tape.

Voltz is directed to a coilable rule with a detachable connection, which is essentially a tape measure with a detachable connection.

Ashworth is directed to a machine belt cut from side of leather.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the references or combine the reference teachings. Second, there must be a reasonable expectation of success. Finally the prior art must teach or suggest all the claimed features of the invention (See MPEP 2143).

A *prima facie* case of obviousness has not been made in that the combination of Takagi et al., Voltz and Ashworth fail meet any of the three criteria to establish a *prima facie* case of obviousness.

First, the combination of Takagi et al., Voltz and Ashworth fails to disclose a grinding belt as recited in the claims. The feature of a "grinding belt" is claimed multiple times throughout claim 1 in lines 1, 6, 7 and 9. The grinding belt is used for grinding or polishing. Takagi et al. is directed to a lapping tape, Voltz is directed to a coilable rule with a detachable connection, which is essentially a tape measure with a detachable connection, and Ashworth is directed to a machine belt cut from sides of leather. The combination of these references do not disclose a grinding belt that grinds and polishes as recited in claim 1.

Secondly, no motivation has been provided to show why someone in the grinding belt industry would look to lapping tape technology as disclosed in Takagi et al., tape measure

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technology as disclosed in Voltz and combine them with Ashworth to solve problems associated with grinding belts as required (see MPEP 2141.01(a) "Analogy in Mechanical Arts").

It is further submitted that hindsight reasoning has been used in rejecting the claims of the present application. The advantages specified in the present applications are used in the outstanding Office Action as the reasoning for combining the references which is improper. MPEP 2143 states that "[t]he teachings or suggestion to make the claimed combination and the reasonable expectation for success must both be found in the prior art, not the applicants disclosure. The fact that the references can be combined or modified is not sufficient to establish prima facie obviousness. "Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." (see MPEP 2142.01 page 2100-124, August 2001 under the heading "FACT THAT THE REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA FACIE OBVIOUSNESS"). Thus from the foregoing, the motivation provided in the Office Action is improper.

Finally, there is no reasonable expectation for success since the combination of all the cited references fails to teach or suggest a "grinding belt" as recited throughout claim 1.

In view of the foregoing, it is respectfully submitted that a prima facie case of obviousness has not been made. Therefore, withdrawal of the rejection of claims 1 and 2 as being obvious in view of Takagi et al. in combination with Ashworth or Voltz is respectfully requested.

Claims 3-14 were rejected under 35 U.S.C. §103 as being unpatentable over Prior Art (Takagi in view of Ashworth or Voltz) and (Muller in view of Angell) and further in view of Smith (U.S. Patent No. 2,361,506).

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Reconsideration and withdrawal of the rejection are respectfully requested.

Claim 3-14 are ultimately dependent on independent claim 1 and therefore include all the features recited in claim 1. Thus, withdrawal of the rejection of claims 3-14 are respectfully requested for at least the same reasons argued in response to the rejection of claim 1 as being unpatentable over Prior Art.

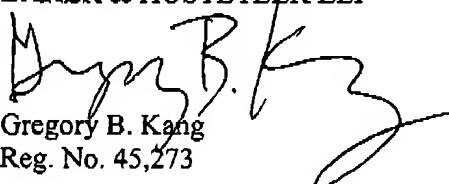
In view of the foregoing, withdrawal of the rejection of claims 3-14 is respectfully requested.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. If it is believed that the application is not in condition for allowance, the Examiner is invited to contact the undersigned if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not time filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036.

Respectfully submitted,

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